

Patent No. 5,909,431), *Shinohara et al.* (U.S. Patent No. 5,351,237), and *O'Neil et al.* (U.S. Patent No. 5,963,547); claims 7 and 10 stand rejected under §103(a) as being unpatentable over *White et al.*, in view of *Kalavade et al.* (U.S. Patent No. 5,961,599); and claims 8, 9 and 11 stand rejected under §103(a) as being unpatentable over *White et al.*, in view of *Kuthyar et al.*, *Shinohara et al.*, and *O'Neil et al.* as applied to claims 1, 4 and 5 above and further in view of *Kalavade et al.* Applicant respectfully traverses each of these rejections.

With respect to the § 102(e) and § 103 rejections of claims 1-12 and claims 17-23, the asserted references, taken alone or in combination, fail to correspond to the invention claimed. For example, each of claims 1-12 and claims 17-23 includes limitations requiring that the audio information being analyzed for the determination also designate a "telephonic communication addressee." Furthermore, according to the claimed invention, the audio information is analyzed to determine whether to send the audio information to a standard telephonic communication path or to an Internet communication path; in this regard, the claim limitations require that the audio information being analyzed for the determination is also sent down the selected path to establish the communication. In contrast, the *White* '890 patent teaches use of a special prefix ("*82") that is neither used to designate a telephonic communication addressee, nor is sent down the selected path to establish the communication. None of the other asserted references overcomes this deficiency in the alleged correspondence.

With particular respect to each of the § 103 rejections, Applicant disagrees that the '547 and '599 patents are prior art. The '547 patent has a filing date of September 18, 1996, and the '599 patent has a filing date of October 15, 1997. The §1.131 Martin Declaration (filed with the August 4, 1999 Office Action Response) establishes the claimed invention as having an effective priority date not later than September 4, 1996. With respect to the '599 patent, even if it was established that the related provisional application disclosed the subject matter relied upon in the instant Office Action (which Applicant requests a copy of should the Examiner attempt to rely on this date in a further rejection), the filing date of the related provisional application is after the effective priority date of the instant application. To the extent needed, Applicant relies on MPEP §§ 715.02 and 715.03, citing various authoritative decisions to explain that the priority entitlement issue turns on whether the inventor had "possession of the invention (*i.e.*, the basic

inventive concept),” and, assuming any differences would have been obvious, the “differences between the claimed invention and the showing” are unimportant.

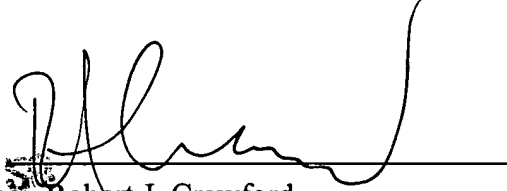
It is not clear that the respective devices and means of claims 12 and 16 can be properly aligned to the asserted prior art. For example, the “device” or “interface means” corresponds, *e.g.*, to a conventional telephone (page 4, lines 26 *et seq.*) with one of its output ports interfacing to a PSTN. In contrast, the Office Action appears to be attempting to align, through the “interface means”, a conventional telephone as being the equivalent of PSTN. The *White* ‘890 patent itself establishes that a conventional telephone is not the equivalent of PSTN.

Applicant further disagrees that there is evidence of motivation to combine the references behind the § 103 rejections; however, in view of the above arguments, Applicant believes it unnecessary to address this issue further.

Accordingly, Applicant submits that each of the claims is in condition for allowance. Reconsideration and withdrawal of the rejections, along with a favorable response, are earnestly requested.

Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at 651/686-6633.

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